UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,121	12/22/2000	Nishanthan M.T. Perinpanathan	91436-268	7915

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SMART AND BIGGAR
438 UNIVERSITY AVENUE
SUITE 1500 BOX 111
TORONTO, ON   M5G2K8
CANADA

EXAMINER
ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 December 2000</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 December 2000</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>03/26/2001</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. Claims 1 – 21 are presented for examination.

Drawings

1.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the tracking instruction must be

shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment

of the application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being amended.

The figure or figure number of an amended drawing should not be labeled as "amended." If a

drawing figure is to be canceled, the appropriate figure must be removed from the replacement

sheet, and where necessary, the remaining figures must be renumbered and appropriate changes

made to the brief description of the several views of the drawings for consistency. Additional

replacement sheets may be necessary to show the renumbering of the remaining figures. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR

1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

by the examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

2.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the synchronization server is a <u>central server</u> must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

        Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tracking instructions must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

        Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being amended.

The figure or figure number of an amended drawing should not be labeled as "amended." If a

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1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

by the examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

4.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because

reference character "104" has been used to designate both UD and OOA. Corrected drawing

sheets are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The replacement sheet(s)

should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to

obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office

action. The objection to the drawings will not be held in abeyance.

Claim Objections

5.   Claim 2 is objected to because of the following informalities: There should be a comma

(,) in-between the words "memory" and "content" so one of ordinary skill in the art will not

mistake "said memory" with "said memory content". This is a recurring deficiency throughout

the claim language. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

7.   Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention. The limitation of, "said

synchronization server is a central server," is not specifically found in the specification.

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

9.   Claims 1, 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

10.   It is unclear in the specification as to what makes a server a "central server".

11.   Claims 3, 4 are 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

12.   Claims 3, 4 and 6 recite the limitation "said synchronization server". There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

14.   Claims 1 – 12 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Imai et

al. U.S. Patent No. 5987510 (hereinafter Imai).

15.   Referencing claim 1, as closely interpreted by the Examiner, Imai teaches a device for

communication with intermittent networking comprising:

16.   a communications interface adapted to communicate with a communications network and

another device for communication, (e.g. col. 7, lines 20 – 51);

17.   an user interface for receiving user inputs, (e.g. col. 7, lines 20 – 51);

18.   memory, (e.g. col. 7, lines 20 – 51);

19.   a processor in communication with said memory, said communications interface and said

user interface, said processor adapting said device to:

20.   track user inputs received through said user interface, (e.g. col. 7, lines 20 – 51 & col. 8,

line 33 – col. 9, line 25);

21.   store said tracked user inputs in said memory, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 –

col. 9, line 25);

22.   using said communications interface, transmit data corresponding to said tracked user

inputs to a synchronizer, said synchronizer being one of said another device communication and

a central server, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 – col. 9, line 25).

23.   Referencing claim 2, as closely interpreted by the Examiner, Imai teaches an output

device for presenting or rendering of content, said output device in communication with said

processor, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 – col. 9, line 25); and

24.   wherein said processor is further adapted to:

25.   prior to tracking said user inputs, retrieve from said memory content for presentation,

(e.g. col. 10, line 47 – col. 11, line 33);

26.   using said output device, present a rendering of said retrieved content, (e.g. col. 10, line 47 – col. 11, line 33); and

27.   wherein said user inputs received correspond to a user's interaction with said content rendered, (e.g. col. 10, line 47 – col. 11, line 33).

28.   Referencing claim 3, as closely interpreted by the Examiner, Imai teaches receive from said synchronization server additional content, (e.g. col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31);

29.   store in said memory said additional content received, (e.g. col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31); and

30.   present to said user a rendering of said additional content using said output device, (e.g. col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31).

31.   Referencing claim 4, as closely interpreted by the Examiner, Imai teaches said additional content received is responsive to said data transmitted to said synchronization server, (e.g. col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31).

32.   Referencing claim 5, as closely interpreted by the Examiner, Imai teaches said additional content received is a pointer to content stored on a computing device, (e.g. col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31).

33.   Referencing claim 6, as closely interpreted by the Examiner, Imai teaches

34.   said processor is further adapted to:

35.   receive from another device for communication data corresponding to tracked user inputs

at said another device, (e.g. col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31); and

36.   wherein said synchronization server is a central server, (e.g. col. 10, line 47 – col. 11, line

33 & Figures 16 – 20 and 23 – 31).

37.   Referencing claim 7, as closely interpreted by the Examiner, Imai teaches said processor

is further adapted to:

38.   prior to tracking said user inputs, retrieve tracking instructions for execution by said

processor, (e.g. col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31); and

39.   wherein said user inputs are tracked by executing said tracking instructions retrieved,

(e.g. col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31).

40.   Referencing claim 8, as closely interpreted by the Examiner, Imai teaches said tracking

instructions comprise an online-offline agent, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 – col. 9,

line 25, *"file display program 130"*).

41.   Referencing claim 9, as closely interpreted by the Examiner, Imai teaches said processor

is further adapted to:

42.   transfer to said another device for communication said tracking instructions after

completion of tracking said user inputs, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 – col. 9, line

25).

43.   Referencing claim 10, as closely interpreted by the Examiner, Imai teaches said processor

is further adapted to:

44.   transmit at least a portion of said content retrieved said to another device for

communication, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 – col. 9, line 25).

45.   Referencing claim 11, as closely interpreted by the Examiner, Imai teaches said processor

is further adapted to:

46.   prior to retrieving, receive said content from said another device for communication; and

47.   store said content retrieved in said memory, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 –

col. 9, line 25).

48.   Referencing claim 12, as closely interpreted by the Examiner, Imai teaches a computer

readable media containing computer instructions, said instructions adapting a network enabled

computing device to:

49.   while offline, track a user's interactions with content, (e.g. col. 7, lines 20 – 51 & col. 8,

line 33 – col. 9, line 25);

50.   while offline, store said tracked interactions in memory, (e.g. col. 7, lines 20 – 51 & col.

8, line 33 – col. 9, line 25); and

51.   while online, transmit data corresponding to said user interactions to at least one of a

synchronization server and another network enabled computing device, (e.g. col. 8, line 33 – col.

9, line 25 & col. 10, line 47 – col. 11, line 33 & Figures 16 – 20 and 23 – 31).

52.   Claim 17 is rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

53.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

54.   Claims 13 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai

(5987510) in view of what is well know in the art.

55.   As per claim 13, as closely interpreted by the Examiner, Imai teaches while online,

communicate with a network enabled computing devices, (e.g. col. 7, lines 20 – 51 & col. 8, line

33 – col. 9, line 25);

56.   while online, receive content from a network enabled computing device, (e.g. col. 7, lines

20 – 51 & col. 8, line 33 – col. 9, line 25); and

57.   store said content received in said memory, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 –

col. 9, line 25), but does not specifically teach said network enabled computing device

communicating with another server.

58.   Examiner takes Official Notice (see MPEP § 2144.03) that " a network enabled

computing device communicating with another server " in a computer networking environment

was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

59.	It would have been obvious to on of ordinary skill in the art at the time the invention was made to utilize what is well known in the art with Imai because if a user wished to gather information that is not on one server, the user would have to find the information on the internet, searching through different servers until the desired information was found. Furthermore, there is no one server that will have every piece of information a user would need.

60.	As per claim 15, as closely interpreted by the Examiner, Imai teaches said instructions for tracking user interactions received are configured for at least one of said content received, said

output device for rendering content and said network enabled computing device, (e.g. col. 7, lines 20 – 51 & col. 8, line 33 – col. 9, line 25).

61.   Claims 14, 16 and 18 – 21 are rejected for similar reasons as stated in the above claims of 1 – 13, 15 and 17 in combination and/or alone.

Conclusion

62.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

63.   a.   Reed et al. U.S. Patent No. 5862325 discloses Computer-based communication system and method using metadata defining a control structure.

64.   b.   Hill et al. U.S. Patent No. 6023714 discloses Method and system for dynamically adapting the layout of a document to an output device.

65.   c.   Lowery U.S. Patent No. 6446111 discloses Method and apparatus for client-server communication using a limited capability client over a low-speed communications link.

66.   d.   Rajan et al. U.S. Patent No. 6633910 discloses Method and apparatus for enabling real time monitoring and notification of data updates for WEB-based data synchronization services.

67.   e.   Lincke et al. U.S. Patent No. 6397259 discloses Method, system and apparatus for packet minimized communications.

68.   f.   Weissman et al. U.S. Patent No. 6212524 discloses Method and apparatus for

creating and populating a datamart.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David E. England whose telephone number is 703-305-5333.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

                                                    David E. England
                                                    Examiner
                                                    Art Unit 2143

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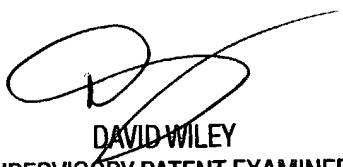
                                                    DAVID WILEY
                                                    SUPERVISORY PATENT EXAMINER
                                                    TECHNOLOGY CENTER 2100